REMARKS

Applicants respectfully request reconsideration an allowance of the above-identified patent application. By this amendment, claims 1-27 and 45-55 remain pending of which 1, 17, and 45 are independent claims describing various embodiments of the present invention.

Initially, Applicants and Applicants' attorney express appreciation to the Examiner for the withdrawal of the previous grounds of rejection. Applicants, however, express their frustration for the refusal from the Office to conduct an Examiner Interview for this case. Since the new grounds of rejection provide newly cited art, Applicants believe that such an interview would be helpful in advancing this case; and therefore, such interview should be granted. As such, Applicants formally request that an interview promptly be scheduled to discuss the following issues in greater detail.

The Office action rejects all the pending claims under 35 U.S.C. § 103(a) as allegedly being unpatentable by U.S. Patent No. 5,668,958 to Bendert et al. ("*Bendert*") in view of U.S. Patent No. 6,706,733 to Komine et al. ("*Komine*").[1] Applicants respectfully traverse this ground of rejection for at least the reason that the Office action fails to establish a *prima facie* case of obviousness.[2] More specifically, the cited art fails to teach, disclose, or enable each and every

[1] Applicants respectfully note that the Office action cites U.S. Patent No. "6,738,971" as *Bendert*; however, this number belongs to Chandrasekaran as noted in the Office action dated March 28, 2006. Since the rejection relying on Chandrasekaran was previously withdrawn, and since *Bendert* is continuously cited in the current rejections, Applicants assume that such reference citation is a typographical error and Applicants will respond as if the appropriate reference number for *Bendert* (i.e., U.S. Patent No. **5,668,958**) was cited. If, however, this assumption is not correct and Chandrasekaran or some other reference was meant to be applied against the current claims, Applicants respectfully request that the next Office action cite the appropriate reference so that they have a full and fair opportunity to respond to such allegations.

Applicants also note that the Office action rejects the claims as allegedly being "anticipated" by the combination of *Bendert* and *Komine*. Since, however, the Office action relies on 35 U.S.C. § 103(a) in its rejection, Applicants also assume that this statement of law for rejecting the claims is a typographical error and Applicants will respond accordingly.

[2] In order to establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143 (emphasis added). In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one or ordinary skill in the art, to modify the references or to combine reference teachings. MPEP § 2143. During

element of Applicants' claimed invention and there is improper motivation for combining reference teachings.

As previously noted, the present invention generally relates to enhanced mechanisms for providing a two-phase commit protocol for transactions that occur across a plurality of databases within a volume. More specifically, embodiments provide that each resource manager in a volume independently maintains a set of transactional metadata used to monitor and control resources or collection of files that are contained within its scope. The scope may be defined based on such things as a directory hierarchy, a file type, a file extension, a timestamp within a common time frame, by file size, a tag stored within a file, etc. Note that *each resource manager independently* controls resources within its *scope* as defined by *transactional metadata* such that no other resource manager within the volume has that same file or resource within its scope. Accordingly, this advantageously allows various options offering different levels of performance, reliability, feature availability, and manageability on a per-resource basis rather than a per volume basis.

The independent claims specifically recite such resource management independence using transactional metadata scoping. For example, claim 1 states, *inter alia*, that "each resource manager [within a volume is] independent from one another such that a file or resource monitored and controlled by a particular resource manager cannot be monitored or controlled by any other resource manager from the [volume]...[and] transactional metadata is maintained based on a scope of control set for each of the [] resource managers by defining a collection of files or resources based on [such things as] a directory hierarchy, a file extension, a file type, a

---

examination, the pending claims are given their broadest reasonable interpretation, i.e., they are interpreted as broadly as their terms reasonably allow, consistent with the specification. MPEP §§ 2111 & 2111.01. Finally, Applicant notes that M.P.E.P. §2141.02 states that the cited references must be considered as a whole, including those sections that "teach away" from the claimed invention. (Citation omitted).

timestamp, a file size, or a tag within the files for which the particular resource manager is responsible.

The cited art of record, however, fails to disclose, suggest, or enable these features. More specifically, *Bendert* discloses a heterogeneous filing system with common API and reconciled file management rules. Although the *Bendert* patent discloses different APIs that control access to different files that they are assigned, these APIs are not independent from one another. For example, *Bendert* states in col. 7, ll. 31-44, that a client can use the Shared File System (SFS) API to access any file in the Byte File System (BFS) container and that a complex set of rules are then used to enforce updates and avoid conflicts. In other words, because *Bendert* allows the SFS API to access any resources typically controlled by the BFS API, and because conflicts exist between the two, the different resources controlled by each interface is not independent of the other. As such, *Bendert* cannot possibly disclose or suggest that *each resource manager within a volume is independent from one another* such that a *file or resource* monitored and controlled by a particular resource manager *cannot be monitored or controlled by any other resource manager*. As such, *Bendert* cannot disclose or suggest the use of *transactional metadata* for maintaining a scope of control set for each of the [] resource managers by defining a collection of files or resources *for which the particular resource manager is responsible*.

Noting some of the deficiencies of *Bendert*, the Office action cites *Komine*. *Komine* discloses an object management and data processing system with a centralized mechanism for managing containment relationships among objects. *Komine*, however, is silent with regards to ensuring consistency in a volume, the independence of resource managers, or the use of transactional metadata for defining the scope of control. Nevertheless, the Office action cites

col. 5, ll. 1-67, of *Komine*, as allegedly disclosing resources managers, "which are independent from each other." Applicants respectfully note, however, that this cited section makes no mention that resource managers independently control or monitor resources within a volume. Instead, this section of *Komine* describes the use and building process of a containment tree representing the *relationships among resource managers*, which is used to determine what requests/responses are directed to or from a particular resource manager. In other words, *Komine* makes no mention that the resources managers are *independent* from one another, and in fact states that the data structure used shows some "relationship" among them, which further indicates that they are NOT independent. In addition, as acknowledged by the Office action, *Komine* is silent with regards to the use of transactional metadata for defining a scope for a resource manager. As such, *Komine* cannot possibly rectify those deficiencies noted above with regard to *Bendert*; and therefore, the combination fails to disclose, suggest, or enable each and every feature of Applicants' claimed invention.

Applicants further note the improper motivation for combining the reference teachings of both *Bender* and *Komine*. For example, the Office action fails to provide a basis in fact that reasonably supports motivation for combining references teachings. In fact, the Office action provides no motivation for such combination. Instead, the Office action simply states that "it would have been obvious to one of ordinary skills in the art at the time of the invention to modify *Bendert's* teaching of shared file system request manager and a byte file system request manager with *Komine's* teachings, which includes RMs 51 to 56, which are independent from each other." (Citation in *Komine* omitted). Applicants respectfully submit that such conclusory statements are insufficient for establishing a *prima facie* case of obviousness.

Applicants note that resent case law has taken a more "flexible" approach in evaluating obviousness by rejecting a rigid application of the "teaching, suggestion, or motivation" test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed before holding the claimed subject matter to be obvious.[3] Nevertheless, such case law has not relieved the Office's obligation to provide at least some modicum of motivation for the combination or modification. In fact, the Court noted that an analysis supporting a rejection of obviousness should be made explicit, and that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. (Citation omitted). Moreover, the Deputy Commissioner for Patent Operations sent a memo to the Technology Center Directors at the USPTO on May 3, 2007, which clearly stated that "it remains *necessary* to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." (Emphasis added). As noted above, however, the Office action in this case provides NO motivation at all to support the combination.

Nevertheless, assuming the Office did provide a reasonable basis in fact for supporting the combination of *Bendert* and *Komine*, a *prima facie* case of obviousness would still fail. For example, as noted above, *Bendert* does NOT indicate that the two APIs (i.e., the SFS and BFS) are independent from one another, but instead simply indicates that files are typed using containers to determine those files under control of the SFS API as opposed to those *normally* accessed using the BFS API. In other words, the above cited section of *Bendert* makes clear that access to files in the BFS system can be made using either BFS API or SFS API; and therefore,

[3] *See KSR Int'l. Co. v Teleflex Inc.*, 550 U. S. ____ (2007)

the BFS API does not have exclusive monitoring and access control to the files defined in its container. Because *Bendert* does not allow independent control of resources using BFS APIs, Applicants respectfully submit that *Bendert* actually "teaches away" from the currently claimed invention that provides for a particular *file* or *resource* monitored and controlled by a particular resource manager *cannot be monitored or controlled by any other resource manager*.

In addition, Applicants note that *Komine* is not directed toward any type of ensuring consistency of files in a volume. Instead, *Komine* is directed towards solving the difficulties associated with adding or removing resources managers since client applications typically maintain a containment tree showing the relationships between them. In other words, since *Komine* attempts to solve a different problem than *Bendert*, which is to provide a single API to a file server for accessing different file systems, one of skill in the art would not be motivated to combine *Komine* teachings with that of *Bendert*. In fact, modifying *Bendert* in the manner suggested would also make *Bendert* inoperable for its intended purpose and would change its principle of operation. That is, since *Bendert* indicates that the SFS API needs to control resources assigned to the BFS API, making the APIs in *Bendert* independent would not provide the common interface that *Bendert* attempts to provide. In addition, because *Komine* attempts to solve a different problem than both *Bendert* and the current claimed invention, *Komine* can be considered non-analogous art.

For at least the foregoing reasons, Applicants respectfully submit that the Office action fails to establish a *prima facie* case of obviousness. As such, Applicants respectfully submit that the cited prior art fails to make obvious Applicants' invention as claimed for example, in independent claims 1, 17, and 45. Applicants note for the record that the remarks above render the remaining rejections of record for the independent and dependent claims moot, and thus

addressing individual rejections or assertions with respect to the teachings of the cited art is unnecessary at the present time, but may be undertaken in the future if necessary or desirable and Applicants reserve the right to do so.

All objections and rejections having been addressed, Applicants respectfully submit that the present application is in condition for allowance, and notice to this effect is earnestly solicited. Should any questions arise in conjunction with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at 1-801-533-9800.

DATED this 17th day of September, 2007.

Respectfully Submitted,

/Wesley C. Rosander, Reg.# 51,030/
Wesley C. Rosander

RICK D. NYDEGGER
Registration No. 28,651
WESLEY C. ROSANDER
Registration No. 51,030
Attorneys for Applicant
Customer No. 047973

RDN/WCR:amh
W:\13768\783.45\SDA0000004611V001.DOC